

AGILENT TECHNOLOGIES  
Legal Department, 51UPD  
Intellectual Property Administration  
P. O. Box 58043  
Santa Clara, California 95052-8043



04-11-01

CPA/1655#  
PATENT APPLICATION

ATTORNEY DOCKET NO. 10981620-1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 13 2001  
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Anticipated Classification of this application:

Class \_\_\_\_\_ Subclass \_\_\_\_\_

Prior application: 09/398,399

Examiner: B. Sisson

Art Unit: 1655

"Express Mail" label no. E1563391037US

Date of Deposit April 9, 2001

I hereby certify that this is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

By M. Pierce

Typed Name: Margaret Pierce

Box CPA  
ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

REQUEST FOR A CONTINUED PROSECUTION APPLICATION (CPA) 37 CFR 1.53(d)

Sir:

This is a request for a filing under the continuing application procedure, 37 CFR 1.53(d), for a  
(☒) continuation  
( ) divisional

Prior Application

Application Serial No. 09/398,399 filed September 17, 1999

Title (as originally filed) Techniques for Assessing Nonspecific Binding of  
Nucleic Acids to Surfaces

Title (as last amended) \_\_\_\_\_

Name of applicant(s) Glenda C. Delenstarr

- (X) The prior application is hereby abandoned.  
(X) The issue fee in the prior application has not been paid.  
(X) Please use all the contents of the prior application file wrapper, including the drawings and entered amendments, as the basic papers for the new application.

Foreign Priority - 35 USC 119

- ( ) Foreign priority under 35 U.S.C. 119 has been claimed in prior application Serial No. \_\_\_\_\_  
filed on \_\_\_\_\_ in \_\_\_\_\_.  
( ) The certified copy has been filed in prior application Serial No. \_\_\_\_\_  
filed \_\_\_\_\_.  
( ) A separate paper claiming direct priority to a foreign application is enclosed herewith. A certified copy of the foreign application will be provided in due course.

Petition for Extension of Time in Prior Application

- (☒) A petition for extension of time is enclosed herewith.

04/12/2001 CCHAU1 00000083 501078 09398399

01 FC:131 710.00 CH  
02 FC:103 342.00 CH  
03 FC:102 160.00 CH

Assignment

- ☐ The prior application is assigned to Agilent Technologies.  
☐ The prior application is assigned to Agilent Technologies and \_\_\_\_\_.  
☐ The prior application is assigned to \_\_\_\_\_.

Inventorship Statement

- ☐ Delete the following named individuals as inventors in this application in accordance with 37 CFR 1.62(a) as a result of a change in the claimed subject matter:
- 

Declaration and Power of Attorney

- ☐ The Power of Attorney in the prior application is to:

Customer Number 022878

Place Customer  
Number Bar Code  
Label here

- ☐ The power appears in the original papers in the prior application.  
☐ The power does not appear in the original papers, but was filed on \_\_\_\_\_.
- ☐ Recognize as Associate Attorney or Agent \_\_\_\_\_  
Registration No. \_\_\_\_\_
- ☐ Authorization is hereby granted by signature below of the Attorney or Agent of record.  
☐ The Associate Attorney or Agent shall not have the authority to appoint other Attorneys or Agents.

Communications

- (X) Address all future communications to:

AGILENT TECHNOLOGIES  
Legal Department, 51UPD  
Intellectual Property Administration  
P.O. Box 58043  
Santa Clara, California 95052-8043

Direct telephone calls to:  
Gordon M. Stewart  
(650) 485-2386

Waiver of Secrecy

It is understood that secrecy under 35 USC 122 is hereby waived to the extent that if information or access is available to any one of the applications in the file wrapper of a CPA application, be it either this application or a prior application in the same file wrapper, the PTO may provide similar information or access to all the other applications in the same file wrapper.

Other Amendments

- ☐ Before calculating the filing fee, amend the prior application as follows:
- ☐ Cancel the following claims \_\_\_\_\_
- ☐ Enter the enclosed Preliminary Amendment.
- ☒ Enter the Amendment(s) under 37 CFR 1.116 dated February 9, 2001  
that was unentered in the Prior Application. A copy of the Amendment(s) is (are) enclosed.
- ☒ Remarks to Accompany CPA

CONTINUED PROSECUTION APPLICATION  
(CPA) (37 CFR 1.53(d)) (continued)

ATTORNEY DOCKET NO. 10981620-1

Fee Calculation


(X) The filing fee is calculated below for (X) Utility ( ) Design

CLAIMS AS FILED BY OTHER THAN A SMALL ENTITY					
(1) FOR	(2) NUMBER FILED		(3) NUMBER EXTRA	(4) RATE	(5) TOTALS
TOTAL CLAIMS	39	— 20	19	X \$18	\$342
INDEPENDENT CLAIMS	5	— 3	2	X \$80	\$160
ANY MULTIPLE DEPENDENT CLAIMS				\$260	\$
BASIC FEE: Design ( \$310.00 ); Utility ( \$760.00 )					\$790
TOTAL FILING FEE					\$1,132
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$390*	3RD MONTH \$870.00	4TH MONTH \$1360.00	\$280
		X			
*\$390 for 2nd month less \$110 for 1st month as paid on 2/9/01 = \$280.00					
TOTAL CHARGES TO DEPOSIT ACCOUNT					\$1,572

Charge \$ 1,572.00 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

By

  
Bret E. Field for  
Gordon M. Stewart  
Attorney/Agent for Applicant(s)  
Reg. No. 37,620


Date: April 9, 2001

Telephone No.: (650) 485-2386



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RESPONSE UNDER 37 CFR §1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 1655

EXPRESS MAIL CERTIFICATE			
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.			
Typed or Printed Name	Margaret Pierce	Signature	
Express Mail No.	EL563391037US	Date	4/9/01

<b>Remarks To Accompany CPA</b>  Address to: Box CPA Commissioner for Patents Washington, D.C. 20231	Attorney Docket	10981620-1
	First Named Inventor	Delenstarr
	Application Number	09/398,399
	Filing Date	September 17, 1999
	Group Art Unit	1655
	Examiner Name	B. Sisson
	Title	Techniques for Assessing Non-Specific Binding of Nucleic Acids to Surfaces

Sir:

The following remarks are prepared to accompany the Continuing Prosecution Application (CPA) filed on even date herewith, and are intended to address issues raised in the Examiner's Advisory Action of February 26, 2001.

#### REMARKS

In the Advisory Action of February 26, 2001, it was asserted that the phrase "14 nucleotides in length to have at least 70% sequence identity with a probe" raises both an issue of new matter and an issue of indefiniteness. Each of these potential issues is now addressed separately.

With respect to the issue of new matter, the specification at page 27, lines 17 to 22 states that: "Generally, a nucleic acid molecule is capable of hybridizing selectively or specifically to a target sequence under moderately stringent hybridization conditions. In the context of the present invention, moderately stringent hybridization conditions generally allow detection of a target nucleic acid sequence of at least 14 nucleotides in length having at least approximately 70% sequence identity with the sequence of the selected nucleic acid probe."

The relevant claim language specifically recites "hybridization conditions that require a target nucleic acid of 14 nucleotides in length to have at least 70% sequence identity with a probe in order to hybridize to said probe." It is respectfully submitted that this claim language

is fully supported by the above section of the specification and therefore does not represent the addition of new matter to the application.

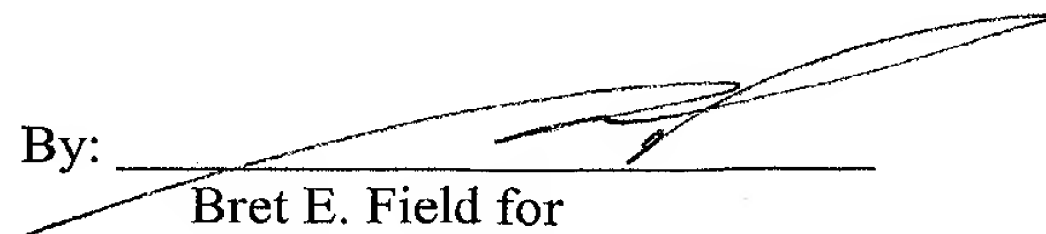
With respect to the asserted indefiniteness issue, it is submitted that one of skill in the art in view of the specification would readily know that the claim requires that at least 70% the 14 nt target nucleic acid must match up perfectly in terms of base pair hybridization with an equal length stretch of the corresponding probe. In other words, at least 10 of the 14 nt of the target nucleic acid must find exact sequential matches in a 14 nt length of the corresponding probe nucleic acid. Put another way, there can be at most 4 mismatches between a 14 nt target nucleic acid and the corresponding 14 nt stretch of a probe nucleic acid. It is respectfully submitted that one of skill in the art would find this language sufficiently definite in terms of the specification to know what the Applicant is claiming. As such, it is respectfully submitted that this language does not raise an issue of indefiniteness.

Finally, inclusion of the specific 5 to 25 nt language in the claims has been asserted to raise an issue of new matter. However, the specification at page 22, line 23 states that "Examples of short probes are shown in Table 5." Table 5 of the specification goes on to provide examples of short probes ranging from 5 to 25 nt. As such, one of skill in the art would read these specific lengths as defining a genus of short probes, particularly in view of the specification's teaching that the probes of Table 5 are "examples" of short probes. Therefore, it is respectfully submitted that the 5 to 25 nt limitation does not introduce new matter to the application.

In view of the above remarks and previously filed amendments which are entered by the accompanying CPA, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815.

Respectfully submitted,

Date: 4. 9. 01

By:   
Bret E. Field for  
Gordon M. Stewart  
Registration No. 37,620

remarks to accompany cpa